

Response Transmittal  
Docket No.: 1000-10-CO1

In The United States Patent and Trademark Office

In re application of: James P. Elia

Group No. 1646

Serial No.: 09/836,750

Examiner: Elizabeth C. Kemmerer, Ph.D.

Filed: 04/17/01

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For: METHOD FOR GROWING MUSCLE IN A HUMAN HEART

SEP 03 2003

TECH CENTER 1600/2900

MAIL STOP NON-FEE AMENDMENTS

Commissioner for Patents

P.O. Box 1450

Arlington, VA 22313-1450

1. Transmitted herewith is a RESPONSE TO REQUIREMENT FOR RESTRICTION for this application.

2. Applicant is a small entity.

3. a)  **Extension of Term**

Extension (months)	Fee for other than <u>small entity</u>
one month	\$ 110.00
two months	\$ 410.00
three months	\$ 930.00
four months	\$1,450.00
five months	\$1,970.00

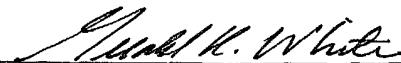
An extension is hereby requested for \_\_\_\_\_ month(s) with a fee of \$\_\_\_\_\_.

An extension for \_\_\_\_\_ months has already been secured and the fee paid therefor of \$\_\_\_\_\_ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$\_\_\_\_\_.

**OR**

b)  Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.



Signature of attorney

Gerald K. White

Type or print name of attorney

Reg. No.: 26,611

Tel. No.: (312) 920-0588

**CERTIFICATE OF MAILING**

I hereby certify that the attached RESPONSE TO REQUIREMENT FOR RESTRICTION was delivered to the Commissioner for Patents by the undersigned from Arrow Intellectual Property Services, 2001, Jefferson Davis Highway, Suite 602, Arlington, Virginia 22202, by hand carrying said RESPONSE TO REQUIREMENT FOR RESTRICTION to Art Unit 1646, Crystal Plaza 1, Tenth Floor, Attention: Examiner Elizabeth C. Kemmerer this 26<sup>th</sup> day of August, 2003.

Dated: 26 August 2003

Ann Rutledge  
Printed Name: Ann Rutledge

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: James P. Elia )  
   ) Group Art Unit: 1646  
   )  
   Serial No.: 09/836,750                      )  
   )  
   ) Examiner: Elizabeth C. Kemmerer, Ph.D.  
   )  
   Filed: April 17, 2001                      )  
   )  
   )  
   For: METHOD FOR GROWING                )  
   ) MUSCLE IN A HUMAN                      )  
   ) HEART                                      )

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**RESPONSE TO REQUIREMENT FOR RESTRICTION**

Mail Stop NON-FEE AMENDMENT  
 Commissioner for Patents  
 P.O. Box 1450  
 Arlington, VA 22313-1450

Sir:

This paper responds to the outstanding Office Action of August 21, 2003 in which the Examiner made a restriction and election requirement for claims 204, 205, and 236-253. A shortened statutory period of one month was set to respond to the Office Action.

The Examiner deemed that three (3) independent and distinct inventions were contained in claims 204, 205, and 236-253 and required Applicant to elect one of such inventions. In response, Applicant provisionally elects, with traverse, to prosecute the claims of the Group III invention, i.e., claims 204, 205, 236-239, and 243-253 (in part).

Applicant respectfully traverses the restriction requirement for reasons set forth more fully below.

First of all, although Applicant elected the Group III invention, Applicant respectfully believes that all of the claims of Groups I-III, i.e.; claims 204, 205, and 236-253, are directed to the same invention because all of such claims are directed to a method of growing a new portion of a pre-existing organ (heart) with use of a growth factor to grow new muscle and thus should be examined along with the claims of the elected invention. In this regard, please note that independent claims 204 and 236 containing the term "growth factor" are generic to the respective

growth factor specie claims which are directed to genes, gene products, and cells. It is pointed out that claims 204 and 236 are included in all three groups identified by the Examiner. Thus, Applicant respectfully believes that the instant fact situation should involve a genus/specie type of requirement for restriction. Accordingly, once claims 204 and 236 are determined to be allowable, the Examiner should act upon all of claims 204, 205, and 236-253.

The restriction requirement postulated that the Group I-III inventions are not capable of use together and have different modes of operation, different functions, or different effects. Applicant respectfully disagrees with the above statement because the inventions are clearly capable of being utilized together (as indicated in the literature) and the growth factors from all of the groups function in the same way to produce the same result.

Thus, the Examiner is respectfully requested to favorably reconsider the outstanding restriction requirement in view of the instant traverse and withdraw the restriction requirement.

Applicant notes that the Examiner was not able to locate in the file the two (2) declarations filed under 37 CFR 1.132 in the file. To expedite the prosecution of the instant application, Applicant encloses copies of such declarations.

It is believed that claims 204, 205, and 236-253 are in condition for examination in view of the above remarks, and an action on the merits of such claims is respectfully requested.

Should the Examiner have any questions or require additional information or discussion to place the application in condition for allowance, a phone call to the undersigned attorney would be appreciated.

Respectfully submitted,

Date: August 25, 2003

  
Gerald K. White  
Reg. No. 26,611  
Attorney for Applicant

GERALD K. WHITE & ASSOCIATES, P.C.  
205 W. Randolph Street, Suite 835  
Chicago, IL 60606  
Phone: (312) 920-0588  
Fax: (312) 920-0580  
Email: [gkwpatlaw@aol.com](mailto:gkwpatlaw@aol.com)

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